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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Giorgio Panin

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EXAMINER

MATTISON, LORI K

ART UNIT

PAPER NUMBER

1619

NOTIFICATION DATE

DELIVERY MODE

02/03/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/579,814	<b>Applicant(s)</b> PANIN, GIORGIO	
	<b>Examiner</b> LORI MATTISON	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08/14/2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-42 is/are pending in the application.
- 4a) Of the above claim(s) 39-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-38 and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Claim Status**

1. Applicant's arguments and amendments to claims 16, 18, 19-24, 28-30, 33, and 34, filed 08/14/2009 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed below in original or modified form is herein withdrawn.
2. Claims 16-42 are pending, claims 1-15 are cancelled, claim 42 is new, claims 39-41 remain withdrawn for the reasons of record, new claim 42 is rejected, and claims 16-38 and 42 have been examined on the merits.

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

New claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's amendment (i.e. the addition of new claim 42 to the claim listing) necessitated the new grounds of rejection.

Instant claim 42 is drawn to "A method." However, instant claim 42 depends from instant claim 18 which is "A composition."

Thus it is unclear whether the preamble of new claim 42 is incorrect and is meant to be "A composition" or whether the dependency of new claim 42 is erroneous and was meant to depend from a method claim.

Clarification is required.

To aid in a more compact prosecution, claim 42 has been interpreted as being a method claim which depends from instant claim 17. Specifically, the claim has been interpreted as, "The method according to claim 18, wherein  $R_f$  has values of number average molecular weight  $M_n$  of between about 500 to 1300."

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 16, 20, 21, 23 and 38 **remain** rejected under 35 U.S.C. 103(a) as being unpatentable over PANTI (See PTO-892 mailed on 5/27/2009) in view of CHEETAM (See PTO-892 mailed on 5/27/2009) for the reasons of record.

In the traverse of the rejection of claims 16, 20, 21, 23 and 38 under 35 USC 103(a) over PANTINI and CHEETAM, Applicant alleges that the invention is directed to a composition which comprises polyphenols and an amount of stabilizing perfluoropolyether to prevent oxidative degradation (Reply, page 10, last paragraph). Applicant alleges that the compositions

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taught by PANTINI are concentrated compositions of perfluoropolyether phosphates that are diluted and added to emulsions to obtain emulsions (Reply, page 11, paragraph 3). Applicant alleges that the stability discussed by PANTINI regards the stability of the emulsion and not the ability of the perfluoropolyether phosphate to provide stability to the polyphenols against oxidation (Reply, page 11, paragraphs 3 and 6). Applicant alleges that PANTINI does not recognize the need to prevent oxidative degradation of polyphenols (Reply, page 11, paragraph 6). Applicant alleges that PANTINI is completely silent with regard to inclusion of polyphenols in the composition (Reply, page 10, paragraph 5). Applicant alleges that there is no motivation to combine the caffeic acid of CHEETAM with the perfluoropolyether of PANTINI. Applicant alleges CHEETAM does not contain any teaching or hints concerning polyphenols degradation.

Applicant's traverse has been considered but is not persuasive.

With regard to Applicant's allegation that PANTINI does not teach that the perfluoropolyether phosphate prevent oxidative degradation of polyphenols, it is observed that the perfluoropolyether phosphate utilized by PANTINI in Example 17, (i.e. Fomblin HC/P2-1000) is the same perfluoropolyether phosphate (i.e. Fomblin HC/P-2000) utilized in Examples 1-3 of the instant specification to stabilize green tea and grape seed extracts (i.e. polyphenols). Since the property of protecting polyphenols from oxidative damage flows from the polyperfluoroethoxymethoxy-difluoroethyl PEG phosphate chemical (i.e. Fomblin HC/P2-1000), it would necessarily flow that the composition of PANTIINI would also have the ability to protect polyphenols from oxidative damage because PANTINI utilize the same polyphenol protecting chemical as that taught and exemplified in the instant specification.

With regard to Applicant's allegation that PANTINI does not recognize the need to prevent oxidative degradation of polyphenols through use of perfluoropolyether phosphate, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In the instant case PANTINI teaches use of perfluoropolyether phosphate (i.e. functionalized perfluoropolyethers) to obtain products for cosmetic and toilet preparations (paragraph 11) and exemplifies a suncream comprising perfluoropolyether phosphate.

With regard to Applicant's allegation that there is no motivation to combine the caffeic acid of CHEETAM with the perfluoropolyether phosphate composition of PANTINI because PANTINI does not teach polyphenols, in response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, PANTIINI teaches that the cosmetic preparations of his invention are for "protection against sun radiations" (paragraph 24) and exemplifies a suncream in Example 17 (paragraph 78 and 79). PATINI teaches and claims inclusion of "sun filters" in the cosmetic compositions (paragraphs, 30, 80, claim 18). Example 3 of CHEETAM teaches that caffeic acid (i.e.polyphenol) has advantageous UV absorption

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qualities and embodies caffeic acid in a sunscreen composition in an amount of 2% by weight (CHEETAM-column 12, lines 30-55). Therefore, the skilled artisan would have been motivated to add the caffeic acid polyphenol of CHEETAM to the perfluoropolyetherphosphate suncream composition of PANTINI because CHEETAM teaches that caffeic acid has advantageous UV absorption qualities. Caffeic acid would also be a desirable suncreening agent for inclusion in the sunscreen composition of PANTINI because caffeic acid has a log P value of about 1, which is the greatest skin penetration value achieved for sunscreen molecules as taught by CHEETAM (column 7, lines 15-30).

Claims 17, 18, 19, 22, and 24 **remain** rejected and **new claim 42 is** rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI and CHEETAM as applied to claims 16, 20, 21, 23, 38, and 42 above, and further in view of SCHLIEMANN-WILLERS (See PTO-892 mailed on 5/27/2009), as evidenced by the Fomblin HC/P2-1000 product information sheet as dated 09/2005 by Solvay Solexis (See PTO-892 mailed on 5/27/2009), for the reasons of record.

With regard to new claim 42, the Rf of the FOMBLIN HC /P2-1000 exemplified in the suncream of PANTINI would have a  $M_n$  of approximately 574.

**Applicant's amendment (i.e. the addition of new claim 42 to the claim listing) necessitated the new grounds of rejection.**

In the traverse of claims 17, 18, 19, 22, and 24 under 35 USC 103(a) over PANTINI in view of CHEETAM and further in view of SCHLIEMANN-WILLERS as evidenced by FOMBLIN HC/P2-1000, Applicant alleges that the combination of PANTINI and CHEETAM have not rendered the claim 16 obvious and that SCHLIEMANN-WILLERS as evidenced by

FOMBLIN HC/P2-1000, have not render claim 16 and all that depend from it obvious (Reply, page 12, paragraph 4) .

Applicant's traverse has been considered but is not persuasive.

The arguments pertaining to PANTINI in view of CHEETAM have been addressed above. SCHLIEMANN-WILLERS, as evidenced by FOMBLIN HC/P2-1000, has been provided to teach the CAS number of FOMBLIN HC/P2-1000, show its chemical structure, and molecular weight.

Claims 25-30 **remain** rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI, CHEETAM, SCHLIEMANN-WILLERS, as evidenced by the FOMBLIN HC/P2-1000 product information sheet, as applied to claims 16-24, 38, and **new claim** 42 above, and further in view of RANDALL (See PTO-892 mailed on 5/27/2009) for the reasons of record.

**Applicant's amendment (i.e. the addition of new claim 42 to the claim listing) necessitated the new grounds of rejection.**

In the traverse of claims 25-30 under 35 USC 103(a) over PANTINI, in view of CHEETAM, SCHLIEMANN-WILLERS, as evidenced by FOMBLIN HC/P2-1000 product information sheet, in further view of RANDALL, Applicant alleges that the combination of PANTINI and CHEETAM have not rendered the claim 16 obvious and that RANDALL would not have rendered claim 16 and all that depend from it obvious (Reply, page 12, paragraph 4)

Applicant traverse has been considered but is not persuasive.

The arguments pertaining to PANTINI in view of CHEETAM have been addressed above. RANDALL has been provided to teach a sunscreen that embodies inclusion of Vitamin E



acetate in an amount of 0.5%, that vitamin E acetate improves skin smoothness and that Vitamin E acetate aids in prevention of free radical damage caused by sun.

Claims 35 and 36 **remain** rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI, CHEETAM, SCHLIEMANN-WILLERS, and RANDALL, as evidenced by the FOMBLIN HC/P2-1000 product information sheet, as applied to claims 16-30, 38, **new claim** 42 above, and further in view of SIDDIQUI (See PTO-892 mailed on 5/27/2009) for the reasons of record.

**Applicant's amendment (i.e. the addition of new claim 42 to the claim listing) necessitated the new grounds of rejection.**

In the traverse of claims 35 and 36 under 35 USC 103(a) over PANTINI, in view of CHEETAM, SCHLIEMANN-WILLERS, and RANDALL as evidenced by FOMBLIN HC/P2-1000 product information sheet, in further view of SIDDIQUI, Applicant argues that the combination of PANTINI and CHEETAM have not rendered the claim 16 obvious and that SIDDIQUI would not have rendered claim 16 obvious.

The arguments pertaining to PANTINI in view of CHEETAM have been addressed above. SIDDIQUI has been provided to show that Vitamin A is a skin protectant which is utilized in sunscreens.

Claims 31-34 and 37 **remain** rejected under 35 U.S.C. 103(a) as being unpatentable over PANTINI, CHEETAM, SCHLIEMANN-WILLERS, RANDALL, and SIDDIQUI, as evidenced by the FOMBLIN HC/P2-1000 product information sheet, as applied to claims 16-30, 35, 36, 38

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**new claim 42** above, and further in view of MENZEL (See PTO-892 mailed on 5/27/2009) for the reasons of record.

**Applicant's amendment (i.e. the addition of new claim 42 to the claim listing) necessitated the new grounds of rejection.**

In the traverse of claims 31-34 and 37 under 35 USC 103(a) over PANTINI, in view of CHEETAM, SCHLIEMANN-WILLERS, RANDALL, and SIDDIQUI as evidenced by FOMBLIN HC/P2-1000 product information sheet, in further view of MENZEL, Applicant argues that the combination of PANTINI and CHEETAM have not rendered the claim 16 obvious and that MENZEL would not have rendered claim 16 obvious.

The arguments pertaining to PANTINI in view of CHEETAM have been addressed above. MENZEL has been provided to show that Vitamin C is an antioxidant which is utilized in sunscreens in an amount of 0.01% to 5.0% to scavenge free radicals and improve cellular viability.

### **Conclusion**

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORI MATTISON whose telephone number is (571)270-5866. The examiner can normally be reached on 8am-6pm (Monday-Thursday).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Wax can be reached on (571)272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LORI MATTISON/

Examiner, Art Unit 1619

/Shanon Foley/

Primary Examiner, Art Unit 1619